

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William Philip SHAOUY et al. Confirmation No. 7307
Appln No. : 09/810,992 Group Art Unit: 2174
Filed : March 16, 2001 Examiner: Peng Ke
For : IMPROVED METHOD AND APPARATUS FOR TAILORING CONTENT
OF INFORMATION DELIVERED OVER THE INTERNET

REPLY BRIEF UNDER 37 C.F.R. 41.41(a)(1)

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
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Sir:

This Reply Brief is in response to the Examiner's Answer dated July 10, 2006, the period for reply extending until September 11, 2006 (September 10, 2006 being a Sunday).

The Examiner maintains the grounds of rejection advanced in the final rejection of claims 1-20 and provides arguments in support thereof.

Appellant notes this Reply Brief is being filed under 37 C.F.R. 41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellant notes it is addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

On the Pages 2-3, section 8 (*Evidence Relied Upon*), the Examiner identifies the prior art relied upon in the prior art rejections. However, the Examiner neglected to list document US Patent No. 6,556,963 to TETZLAFF. Appellant notes that the Examiner has continued to apply this document in the rejection of claim 7 (see page 11 of the Examiner's Answer).

Second Issue

On the Pages 14 and 15, section 10 (*Response to Arguments*), the Examiner asserts that Forecast Pro teaches both a personalizing engine and an arbiter and explains that "Forecast Pro's forecasting models is analogous to applicant's personalizing engine." The Examiner has not fully and properly considered each of the features recited in claim 18.

Independent claim 18 does not merely recite an arbiter and a personalizing engine. Instead, claim 18 recites a method for tailoring information delivered to a user, comprising: an arbiter selecting a personalization engine by analysis of at least one profile element; and the personalization engine selecting a personalized content object to tailor information provided to the user.

The Examiner is not correct that the expert system disclosed in FORECAST PRO can be characterized as the recited arbiter and that "Forecast Pro's forecasting models is analogous to applicant's personalizing engine." An expert system is not an arbiter and a forecasting technique is not a personalization engine. Claim 18 requires that the arbiter select a personalization engine by analyzing at least one profile element. The expert

system in FORECAST PRO, on the other hand, merely analyzes data and “selects the appropriate forecasting technique”. By way of non-limiting example, an arbiter outputs a request object, and enables and selects one of the personalization engines (see page 6, lines 10-19 of the specification).

Furthermore, a personalization engine is a type of engine which decides how information is tailored (see page 7, lines 5-9 of the specification). By way of non-limiting example, the instant specification describes the personalized content object 210 as comprising information tailored to the advantage of the user or the application program (see page 5, lines 15-23). The disclosure of FORECAST PRO, on the other hand, does not contain any language explaining that the forecast technique includes information tailored to the advantage of the user or the application program.

Third Issue

On the Page 16, section 10 (*Response to Arguments*), the Examiner asserts that because “Kadowaki teaches passing of the user ID and password, Kadowaki teaches passing of at least one profile elements”, and cites col. 18, lines 38-61 of KADOWAKI. The Examiner has not fully and properly considered each of the features recited in claim

1. The cited language of KADOWAKI merely states the following:

When a description designating personalization is found in a print job, as shown in FIG. 16A, the printer controller 41 sends apparatus ID information 64-2 of the printer controller 41, machine type ID information 64-3, machine type group ID information 64-4, user ID information 64-5, and a password 64-6 to the personalizing server 3-1 having a certain network address 64-1. The network address 64-1 of the personalizing server 3-1 is acquired as a part of user ID information described in the print job. The apparatus ID information 64-2 uniquely identifies the corresponding apparatus. More specifically, the network address of the printer controller 41 is used. The machine type ID information 64-3 identifies the machine type of printer by a number, e.g., 1 for a type X printer of a company A, 2 for a type Y printer of the company A, and 3 for a type Z printer of a company B. The machine type group ID information 64-4 identifies the machine type group

by a number, e.g., 1 for a copying machine, 2 for a facsimile apparatus, and 3 for a printer. The user ID information 64-5 uniquely identifies the current user who has transmitted a print job currently being processed. The password 64-6 authenticates whether the user who has transmitted a print job is a user who is authorized to use the printer. This password 64-6 is acquired as a part of user ID information described in a print job.

Appellant fails to see the relevancy of the above-noted language. Claim 1 recites passing a request object containing at least one profile element to an arbiter. Clearly, the noted language of KADOWAKI does not specifically disclose this feature. Furthermore, there is no basis for the Examiner's assertion that a printer controller is an arbiter. An arbiter outputs a request object, and enables and selects one of the personalization engines (see page 6, lines 10-19 of the specification).

Fourth Issue

On the Page 16, section 10 (*Response to Arguments*), the Examiner asserts that because "Kadowaki teaches accessing a content database to retrieve a personalized content object because Kadowaki's personal server has a database, which upon user's request would extract personalizing information of a particular user", and cites col. 18, line 60 to col. 19, line 11 of KADOWAKI. Appellant respectfully disagrees. Again, the Examiner has not fully and properly considered each of the features recited in claim 1. The cited language of KADOWAKI merely states the following:

the personalizing server 3-1 first checks the user ID information and the password. If the personalizing server 3-1 authenticates that the user is an authorized user, the personalizing server 3-1 extracts personalizing information managed by itself and stored for an apparatus of that user.

Appellant fails to see the relevancy of the above-noted language with respect to claim 1. Claim 1 recites actively selecting, by analysis of the at least one profile element, a personalization engine from a plurality of personalization engines by the arbiter. While

the Examiner has characterized this feature as “accessing a content database to retrieve a personalized content object”, such a characterization is beside the point and does not reflect what is actually claimed for reasons which are self-evident, i.e., the noted language of KADOWAKI, even assuming the Examiner is correct in his characterization of the disclosed language, simply does not disclose selecting, by analysis of the at least one profile element, a personalization engine from a plurality of personalization engines by the arbiter, much less, doing so actively.

Fifth Issue

While acknowledging, on page 5 of the Examiner's Answer, that KADOWAKI fails to disclose actively selecting, by analysis of the at least one profile element, a personalization engine from a plurality of personalization engines with an arbiter, wherein the arbiter refines and alters a selection based on a number and type of the profile element, the Examiner nevertheless asserts that this feature is taught by FORECAST PRO.

Appellant respectfully disagrees. First, the Examiner has not responded to Appellant's argument in the Appeal Brief in section 10 of the Examiner's Answer. Second, while it can be argued that FORECAST PRO discloses analyzing data in order to select an appropriate forecasting technique, such disclosure is hardly suggestive of actively selecting, by analysis of the at least one profile element, a personalization engine from a plurality of personalization engines by the arbiter, the arbiter refining and altering a selection based on a number and type of the profile element. FORECAST PRO simply does not disclose this feature and bears no relationship or relevance, whatsoever, to this recited feature.

Sixth Issue

In section 10 (*Response to Arguments*), the Examiner neglects to set forth any response to Appellant's assertion that there is no proper basis for combining the teachings of the applied documents. In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason *why* one of ordinary skill in the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972 (B.P.A.I. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). As noted above and in the Appeal Brief, each of the applied documents is silent with regard to a number of recited features and each of the document relate to systems which function in different manners. Moreover, none of the documents teach or suggests modifying the structure or operation of either FORECAST PRO or KADOWAKI in the manner asserted by the Examiner.

Because the art of record fails to provide any reasonable explanation why one ordinarily skilled in the art would utilize such an arrangement, and/or fails to disclose or suggest the problems that such an arrangement would address, Appellant submits that the art of record fails to provide the requisite motivation or rationale as to *why* one ordinarily skilled in the art would modify FORECAST PRO or KADOWAKI in the manner asserted by the Examiner. That is, Appellant submit that because the Examiner has not set forth an articulable reason found in the art of record for modifying FORECAST PRO

or KADOWAKI in the manner asserted by the Examiner, the instant rejection has no basis in the art of record, such that the rejection is improper and should be withdrawn.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). As stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984):

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Appellant submits that the only reason to combine the teachings of the applied references in the manner proposed by the Examiner is the result of a review of Appellant's disclosure and the application impermissible hindsight.

Accordingly, in view of the above-noted arguments (as well as those already of record), the Board is respectfully requested to reverse the Examiner's decision to finally reject claims 1-20 under 35 U.S.C. §§ 102(a) and 103(a), and that the application be remanded to the Examiner for withdrawal of the rejection over the applied documents and an early allowance of all claims on appeal.

CONCLUSION

For the reasons expressed above, Appellant respectfully requests that the grounds of rejection advanced by the Examiner be reversed. Appellant further requests that the application be returned to the Examining Group for prompt allowance.

Although neither a fee nor an extension of time is believed to be due with this Reply Brief, if an extension of time is necessary, Appellant respectfully requests an extension of time under 37 C.F.R. 1.136 for as many months as would be required to render this submission timely. Further, the Commissioner is hereby authorized to charge any additional fee due to Deposit Account No. 09-0457.

Respectfully submitted,
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September 11, 2006
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